

## **REMARKS**

### **Status of the Claims**

The Office Action dated December 1, 2005 has been received and reviewed by the applicant. Claims 1; 2, 6, 8, 12, 13, 17, 19, and 21 are pending in the application. Claims 3-5, 7, 9-11, 14-16, 18, 20, 22-38 were previously cancelled. Claims 1, 2, 6, 8, 12, 13, 17, 19, and 21 stand rejected. Claims 1 and 17 have been amended in this response.

### **Claim Rejections Under 35 USC § 102(e)**

#### **Claim 1**

Claim 1 was rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by Kim et al (US 2005/0167505 A1; “Kim”). Applicants respectfully traverse in light of the amendments above and the remarks below.

Applicants have amended claim 1 to clarify the claimed invention, and thus believe that this amendment overcomes or otherwise renders the Examiner’s rejection moot. Support for Applicants’ amendment with respect to this amendment may be found, by way of example, in Applicants’ specification at lines 1-10, page 13 of Applicants’ specification.

As the Examiner would agree, a claim is anticipated only if each and every element of the claim is found in a single prior art reference. See, MPEP §2131. Applicants submit that Kim fails in this regard with respect to claim 1.

Claim 1 currently recites, *inter alia*, “... the step of forming the watermark pattern using at least two colorants, but fewer than N colorants at each spatial location of the watermark pattern ...”. Claim 1, *supra*. At the least, this element of claim 1 does not read upon Kim as Kim does not teach, disclose or suggest this element. Kim discloses the embedding of blocks of dot code where *each* block is embedded in two different colors – one color for each block. Kim, at para. [0009], [0013], [0018] and [0060] (emphasis added). See also, Kim, at Figs. 3, 10 & 10A. Each color in Kim is presented separately in different bands. See, Kim, at para. [0009], [0013], [0018], [0060] and [0071]. See also, Kim, at Figs. 3, 10 & 10A. However, Kim fails to teach, disclose or suggest any

configuration where the color bands overlay each other, appear simultaneously or are used at the same location on the printing medium.

As such, because Kim fails to teach, disclose or suggest all the features of claim 1, Applicants believe that claim 1 is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejection of claim 1 under 35 U.S.C. § 102(e) is respectfully requested.

**Claim Rejections Under 35 USC § 103(a)**

Claims 1, 2, 6, 8, 12, 17, 19 and 21 were rejected by the Examiner under 35 U.S.C. §103(a) being unpatentable over Lowe et al (US 2003/0012569 A1; "Lowe") in view of Kim et al (US 2005/0167505 A1; "Kim"). Applicants respectfully traverse.

**Claim 1**

Claim 1 was rejected by the Examiner under 35 U.S.C. §103(a) being unpatentable over Lowe et al (US 2003/0012569 A1; "Lowe") in view of Kim et al (US 2005/0167505 A1; "Kim"). Applicants respectfully traverse in light of the amendment above and the remarks below.

As the Examiner would agree, a *prima facie* case of obviousness is made when all the claim limitations are taught or suggested by the prior art. See, MPEP §2143.03. Applicants submit that Lowe and Kim, separately or in combination fail in this regard with respect to claim 1.

Claim 1 recites, *inter alia*, "A method for recording a watermark pattern on a color recording medium ... using at least two colorants, but fewer than N colorants ...". Lowe, as even the Examiner admits (See, Office Action at 3), fails to disclose this element of claim 1. Combining Lowe with Kim does not permit such a combination to reach the standard for a *prima facie* finding of obviousness as will be seen below.

Claim 1 additionally recites, *inter alia*, "... the step of forming the watermark pattern using at least two colorants, but fewer than N colorants at each

spatial location of the watermark pattern ... “. Kim fails to teach, disclose or suggest this feature of claim 1 as Kim only discloses the use of separate bands of colors used for the embedding of blocks of dot code; each block being embedded in a different color. See, Kim, at para. [0009], [0013], [0018], [0060] and [0071]. See also, Kim, at Figs. 3, 10 & 10A. Kim does not disclose the use of both colors at the same location on the printing medium. Further, as Kim relies on this separate color-band configuration (see, Kim at para. [0071]), Kim teaches away from claim 1 as there is no color overlay or use of two or more colors at a given location.

Accordingly, because neither Lowe or Kim, separately or in combination, teaches, discloses or suggests all of the features of claim 1, and because Kim teaches away from claim 1, Applicants believe that a *prima facie* case of obviousness has not been made and as such, claim 1 is in condition for allowance. Reconsideration and withdrawal of the Examiner’s rejection of claim 1 under 35 U.S.C. §103(a) is respectfully requested.

Claims 2, 6, 8 and 12

Claims 2, 6, 8 and 12 were also rejected by the Examiner under 35 U.S.C. §103(a) being unpatentable over Lowe et al (US 2003/0012569 A1) in view of Kim et al (US 2005/0167505 A1). Applicants respectfully traverse.

As the Examiner would further agree, where an independent claim is nonobvious in light of prior art, every dependent claim depending from the independent claim is also nonobvious. See, MPEP §2143.03. Claims 2, 6, 8 and 12 depend from claim 1 either directly or indirectly and as such, incorporate the features of claim 1. As such, Applicants submit the same arguments as submitted for claim 1, *supra* as such arguments apply equally for claims depending from claim 1. In addition, claims 2, 6, 8 and 12 provide separate bases for patentability over and beyond those for claim 1. Further, because Applicants have shown that a *prima facie* case of obviousness has not been made for claim 1 *supra*, consequently, a *prima facie* case of obviousness has not been made with respect to claims 2, 6, 8 and 12.

Accordingly, because neither Lowe or Kim, separately or in combination teaches, discloses or suggests all the features of claims 2, 6, 8 and 12 as Applicants have stated above, Applicants believe that a *prima facie* case of obviousness has not been made and that claims 2, 6, 8 and 12 are also in condition for allowance. Reconsideration and withdrawal of the Examiner's rejection of claims 2, 6, 8 and 12 under 35 U.S.C. §103(a) is respectfully requested.

*Claim 13*

Claim 13 was also rejected by the Examiner under 35 U.S.C. §103(a) being unpatentable over Lowe et al (US 2003/0012569 A1) in view of Kim et al (US 2005/0167505 A1) in further view of "well known prior art". Applicants respectfully traverse.

As the Examiner would further agree, where an independent claim is nonobvious in light of prior art, every dependent claim depending from the independent claim is also nonobvious. See, MPEP §2143.03. Claim 13 depends from claim 1 indirectly through claim 2 and as such, incorporates the features of claims 1 and 2. As such, Applicants submit the same arguments as submitted for claims 1 and 2 *supra*, because such arguments apply equally for claims depending from claims 1 and 2. In addition, claim 13 provides separate bases for patentability over and beyond those for claims 1 and 2. Further, because Applicants have shown that a *prima facie* case of obviousness has not been made for claim 1 *supra*, consequently, a *prima facie* case of obviousness has not been made with respect to claim 13. Further still, Applicants respectfully traverse the Examiner's rejection of claim 13 in view of "well known prior art" as the Examiner has not proffered any evidentiary support for this aspect of the rejection. As such, in the absence of any proffered evidence with respect to the "well known prior art", Applicants respectfully request a withdrawal of the Examiner's rejection based on such "well known prior art".

Accordingly, because neither Lowe or Kim, separately or in combination teach, discloses or suggests all the features of claim 13 as Applicants have stated above, Applicants believe that a *prima facie* case of obviousness has not been made and that claim 13 is also in condition for allowance.

Reconsideration and withdrawal of the Examiner's rejection of claim 13 under 35 U.S.C. §103(a) is respectfully requested.

Claim 17

Claim 17 was also rejected by the Examiner under 35 U.S.C. §103(a) being unpatentable over Lowe et al (US 2003/0012569 A1) in view of Kim et al (US 2005/0167505 A1). Applicants respectfully traverse in light of the amendments above and the remarks below.

Applicants have amended claim 17 to clarify the claimed invention, and thus believe that this amendment overcomes or otherwise renders the Examiner's rejection moot. Support for Applicants' amendment with respect to this amendment may be found, by way of example, in Applicants' specification at lines 1-10, page 13 of Applicants' specification.

As the Examiner would agree, a *prima facie* case of obviousness is made when all the claim limitations are taught or suggested by the prior art. See, MPEP §2143.03. Applicants submit that Lowe and Kim, separately or in combination fail in this regard with respect to claim 17.

Claim 17 recites, *inter alia*, "A method for recording a watermark pattern on a photosensitive color recording medium having at least a cyan colorant-producing component, a magenta colorant-producing component and a yellow colorant-producing component ...". Lowe, as the Examiner admits (See, Office Action at 3) fails to disclose this element of claim 17. Combining Lowe with Kim does not permit such a combination to reach the standard for a *prima facie* finding of obviousness as will be seen below.

Claim 17 additionally recites, *inter alia*, "... the step of exposing the watermark pattern to both the magenta colorant producing component and the yellow colorant-producing component but not to the cyan colorant-producing component of the color recording medium at each spatial location of the watermark pattern ... ". Kim fails to teach, disclose or suggest this feature of claim 17 as Kim only discloses the use of separate bands of colors used for the

embedding of blocks of dot code; each block being embedded in a different color. See, Kim, at para. [0009], [0013], [0018], [0060] and [0071]. See also, Kim, at Figs. 3, 10 & 10A. Kim does not disclose the use of both colors at the same location on the printing medium.

Because neither Lowe or Kim, separately or in combination, teaches, discloses or suggests all of the features of claim 17, Applicants believe that a *prima facie* case of obviousness has not been made and as such, claim 17 is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejection of claim 17 under 35 U.S.C. §103(a) is respectfully requested.

Claims 19 and 21

Claims 19 and 21 were also rejected by the Examiner under 35 U.S.C. §103(a) being unpatentable over Lowe et al (US 2003/0012569 A1) in view of Kim et al (US 2005/0167505 A1). Applicants respectfully traverse.

As the Examiner would agree, where an independent claim is nonobvious in light of prior art, every dependent claim depending from the independent claim is also nonobvious. See, MPEP §2143.03. Claims 19 and 21 depend from claim 17 and thus, incorporate the features of claim 17. As such, Applicants submit the same arguments as submitted for claim 17, *supra* because such arguments apply equally for claims depending from claim 17. In addition, claims 19 and 21 provide separate bases for patentability over and beyond those for claim 17. Further, because Applicants have shown that a *prima facie* case of obviousness has not been made for claim 17 *supra*, consequently, a *prima facie* case of obviousness has not been made with respect to claims 19 and 21.

Accordingly, because neither Lowe or Kim, separately or in combination teach, discloses or suggests all the features of claims 19 and 21 as Applicants have stated above, Applicants believe that a *prima facie* case of obviousness has not been made and that claims 19 and 21 are also in condition for allowance. Reconsideration and withdrawal of the Examiner's rejection of claims 19 and 21 under 35 U.S.C. §103(a) is respectfully requested.

**Double Patenting**

In response to the Double Patenting raised by the Examiner, please find enclosed a Terminal Disclaimer for prior Patent No. 6,980,226.

**Cited Art**

The Examiner considered Wicker (US 2003/0030271 A1) and Heckman et al (US 5291243 A) to be of record and pertinent to Applicants' disclosure. The Examiner did not rely upon these references for any rejections in the Office Action. In the absence of any rejection relating to these references, Applicants believe that the claims covered in Applicants' disclosure are patentable over these references and reserve the right to present supporting arguments in this regard.

**Summary**

Should the Examiner consider that additional amendments are necessary to place the application in condition for allowance, the favor is requested of a telephone call to the undersigned counsel for the purpose of discussing such amendments.

For the reasons set forth above, it is believed that the application is in condition for allowance. Accordingly, reconsideration and favorable action are respectfully solicited.

Respectfully submitted,



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Peyton C. Watkins  
Attorney for Applicant(s)  
Registration No. 36,390

Peyton C. Watkins/lam  
Rochester, NY 14650  
Telephone: 585-477-8282  
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.